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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,022	06/30/2000	Paul Lapstun	NPA072US	9026

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EXAMINER	
SUBRAMANIAN, NARAYANSWAMY	
ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/608,022	LAPSTUN ET AL.	
	Examiner	Art Unit	
	Narayanswamy Subramanian	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,8-21,24-31,36-43 and 48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,8-21,24-31,36-43 and 48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/18/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to communication dated February 3, 2005. Amendments to claim 1 and 29 and cancellation of claims 22-23 and 45-46 have been entered. Claims 1-3, 8-21, 24-31, 36-43 and 48 are currently pending and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

3. Claims 1-3, 8-21, 24-31, 36-43 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term " substantially simultaneously " in claims 1 and 29 is a relative term, which renders the claim indefinite. The term "substantially simultaneously" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claims 2-3, 8-21, 24-28, 30-31, 36-43 and 48 are rejected because they depend on a rejected claim. Appropriate correction/clarification is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-3, 8-21, 24-31, 36-43 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al (US Patent 6,081,261) in view of Bennett et al (US Patent 5,051,736) and further in view of Patterson, Jr. et al (US Patent 5,797,002) and Ur (6,072,871).

With reference to claims 1 and 29, Wolff discloses a method and an apparatus of enabling a buyer to submit a bid, the method including the steps of: receiving, in a computer system, indicating data from a sensing device regarding the identity of a printed paper form and a position of the sensing device relative to the printed form, the form including coded data indicative of an identity of the form and of a plurality of reference points of the form, the sensing device, when placed in an operative position relative to the form, sensing the indicating data using at least some of the coded data; and identifying, in the computer system and from the indicating data, at least one parameter relating to sensored data (See Wolf Abstract, Column 1 lines 44-46, Column 1 line 59 – Column 2 line 13, Column 2 line 44 – Column 3 line 65).

Wolff does not explicitly teach the steps of the form containing visible information relating to a bid transaction being provided to the auction buyer; where the sensored data includes at least one parameter relating to the bid transaction and the coded data identifying a unique location of each of the reference points relative to a form and wherein the visible information and the invisible coded data are printed substantially simultaneously and wherein at the time of printing the computer system associates the type and spatial extent of the coded data with the spatial extent of at least some of the visible information.

Bennett teaches the step wherein the coded data identifying a unique location of each of the reference points relative to a form (See Bennett Abstract, Column 3 lines 40-50, claim 1)

Both Wolff and Bennett are concerned with entering data into a computer from pre-printed sources. It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps taught by Bennett to the invention of Wolff. The combination of the disclosures taken as a whole suggests that users would have benefited from the ease of entering data from pre-printed sources compared to manual entry of such data.

Both Wolff and Bennett fail to teach the steps of the form containing information relating to a bid transaction being provided to the auction buyer, the step where the sensored data includes at least one parameter relating to the bid transaction and wherein the visible information and the invisible coded data are printed substantially simultaneously and wherein at the time of printing the computer system associates the type and spatial extent of the coded data with the spatial extent of at least some of the visible information.

Patterson discloses the steps wherein forms contain information relating to a bid transaction being provided to a user and the sensored data includes at least one parameter relating to the bid transaction (See Column 13 line 20 – Column 15 line 55). The step where the user is an auction buyer is old and well known in the art.

Wolff, Bennett and Patterson are concerned with making it easier and faster for the user to enter data. It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps taught by Patterson to the disclosures of Wolff. The combination of the disclosures taken as a whole suggests that auction buyers would have benefited from being able to use a using a printed form, electronically storing its contents and quickly retrieving its contents as needed.

Wolff, Bennett and Patterson fail to teach the step wherein the visible information and the invisible coded data are printed substantially simultaneously and wherein at the time of printing the computer system associates the type and spatial extent of the coded data with the spatial extent of at least some of the visible information.

Ur teaches the step wherein the visible information and the invisible coded data are printed substantially simultaneously and wherein at the time of printing the computer system associates the type and spatial extent of the coded data with the spatial extent of at least some of the visible information (See Column 4 lines 19-54).

Wolff, Bennett, Patterson and Ur are concerned with making it easier and faster for the user to enter and read data. It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps taught by Ur to the disclosures of Wolff. The combination of the disclosures taken as a whole suggests that users would have benefited from being print visible and invisible data simultaneously and thereby save printing time.

With reference to Claims 2 and 30, Wolff discloses a method and apparatus of claims 1 and 29 respectively, in which said at least one parameter relating to the sensored data is associated with at least one zone of the form and in which the method includes identifying, in the computer system and from the zone relative to which the sensing device is located, said at least one parameter (See Wolff Column 3 lines 37-65).

With reference to Claims 3 and 31, Wolff discloses a method and apparatus of claims 2 and 29 respectively, including receiving, in the computer system, data regarding movement of the sensing device relative to the form, the sensing device sensing its movement relative to the form using at least some of the coded data (See Wolff Column 1 line 49 – Column 2 line 13);

and identifying, in the computer system and from said movement being at least partially within said at least one zone, said at least one parameter of the sensored data (See Wolff Column 4 lines 21-38).

With reference to Claims 8, 9, 36 and 37, Patterson discloses a method and apparatus of claims 2 and 29 respectively, in which the parameter is an action parameter of the bid transaction, the method including effecting, in the computer system, an operation in respect of the action parameter including placing a bid (See Patterson Column 13 lines 20-32).

With reference to Claim 10, Patterson discloses a method of claim 3, in which the parameter is an option parameter of the bid transaction, the method including identifying, in the computer system, that the buyer has entered a hand-drawn mark by means of the sensing device and effecting, in the computer system, an operation associated with the option parameter (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 15 line 55).

With reference to Claims 11 and 38, Patterson discloses a method and apparatus of claims 10 and 36 respectively, in which the option parameter is associated with placing a bid (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 15 line 55).

With reference to Claims 12 and 13, Patterson discloses a method of claim 3, in which the parameter is a text parameter of the bid transaction, the method including identifying, in the computer system, that the auction buyer has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter including converting, in the computer system, the handwritten text data to computer text (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 15 line 55).

With reference to Claims 14 and 39, Patterson discloses a method and apparatus of claims 13 and 36 respectively, in which the text parameter is associated with at least one of a name of the buyer, item search text, and a bid amount (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 15 line 55).

With reference to Claims 15 and 16, Patterson discloses a method of claim 3, in which the parameter is an authorization parameter of the bid transaction, the method including identifying, in the computer system, that the auction buyer has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter including verifying, in the computer system, that the signature is that of the buyer (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 15 line 55). The verifying step is inherent in the disclosure of Patterson.

With reference to Claims 17 and 40, Patterson discloses a method and apparatus of claims 16 and 36 respectively, in which the authorization parameter is associated with authorization of placing a bid (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 15 line 55).

With reference to Claims 18, 19 and 41, Wolff teaches the step in which the parameter is a picture parameter, an operation associated with the picture parameter which in turn is associated with a picture of a listed item (See Wolff Column 3 lines 15-20).

With reference to Claims 21, 28 and 48, Wolff discloses a method and apparatus of claims 1 and 29 respectively, includes printing the form on demand and printing the form on a surface (Inherent in the disclosure of Wolff).

Wolff, Bennett, Ur and Patterson combined do not explicitly disclose printing on multiple pages and in which the method includes binding the pages.

Official notice is taken that this step are old and well known in the art. Printing on multiple pages and binding them helps keep the records together.

It would have been obvious to one with ordinary skill in the art at the time of invention to include this step to the disclosures of Wolff. The combination of the disclosures taken as a whole suggests that users would have benefited from keeping the records together by printing on multiple pages and binding them.

With reference to Claims 24, 26, 47 and 43, Wolff discloses a method and apparatus of claims 1 and 29 respectively, including retaining a retrievable record of each form generated, the form being retrievable using its identity as contained in its coded data and in which the sensing device contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user and in which the method includes monitoring, in the computer system, said identity (Inherent in the disclosure of Wolff).

With reference to Claims 25 and 27, Patterson discloses a method of claim 1, including distributing a plurality of the forms using communications protocols (See Patterson Column 19 lines 11-27 and Column 23 lines 44-47) and including providing all required information relating to the bid transaction in the form to eliminate the need for a separate display device (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 16 line 55). The communications protocols are interpreted to include a mixture of multicast and pointcast communications protocols.

Response to Arguments

6. Applicant's arguments with respect to claims 1-3, 8-31, 36-46 and 48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 272-0315.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian
May 9, 2005

Jagdish N. Patel
Primary Examiner